

REMARKS

1. Rejection of claims 1-19 under 35 U.S.C. 8103(a) as obvious over Lahrman et al., U. S. Patent 5,425,970, (hereafter "Lahrman" or "970").

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP 2143*

Lahrman does not meet this standard and thus fails to provide a prima facie case of nonobviousness. In particular, Lahrman fails to (1.) disclose all of the limitations required by Applicants' amended independent claim 1, and (2.) provide any motivation to modify Lahrman's disclosures so as to obtain Applicants' claimed inventions.

A. LAHRMAN'S TEACHINGS.

Lahrman teaches a process for the production of multi-coat lacquers that requires the use of two *separate* clearcoats. At least one of the clearcoats must be a heat-curable clearcoat while '...at least one *further* clear lacquer coat' must be applied that is a radiation-curable coating which is cured by UV radiation or electron beam radiation. See '970, *Abstract and claim 1*.

Thus, it is a required operational principle of Lahrman that two separate clearcoats be used, one that is heat cured and another that is cured with UV radiation or electron beam radiation. That is, Lahrman explicitly requires the use of two separate clearcoats, each of which clears by a distinct curing mechanism.

It is the PTO's position that Example 6 of the '970 patent teaches the use of a composition containing Applicants' components (a1) and (a3) and that it would be obvious to include a non-radiation curable binder containing isocyanate reactive groups

because Example 6 uses a polyisocyanate. However, the polyisocyanate in Example 6 is used only in the radiation curable clearcoat. The isocyanate groups react with hydroxyl functionality present on radiation curable components of the radiation curable clearcoat.

B. LAHRMANN FAILS TO DISCLOSE ALL OF THE LIMITATIONS REQUIRED IN APPLICANTS' CLAIM 1.

In particular, Lahrmann fails to disclose or suggest the use of a thermally curable binder component (a2) that has less than 5% by weight of aromatic ring moieties and at least two functional groups reactive with the functional groups (a31) of thermally curable crosslinkable component (a3), based on the nonvolatile weight of component (a2).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974); *MPEP 1243.03*. All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

C. LAHRMANN FAILS TO PROVIDE A MOTIVATION TO LIMIT THE THERMALLY CURABLE BINDER COMPONENT (A2) TO THOSE THERMALLY CURABLE BINDER COMPONENTS HAVING LESS THAN 5% BY WEIGHT OF AROMATIC RING MOIETIES.

Although col. 6, lines 65-69 and col. 7, lines 1-11 of the '970 patent discuss the optional use of binders that are not susceptible to radiation induced curing, nothing teaches or suggests the importance of using only those thermally curable binders having less than 5% by weight of aromatic ring moieties. Indeed, Lahrmann is completely silent as to this aspect of the invention set forth in claim 1.

A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Rinehart*, 189 U.S.P.Q. (C.C.P.A. 1976).

In this case, Lahrmann cannot suggest the claimed subject matter because Lahrmann is completely silent as to any discussion of the importance of the structure of a thermally curable binder. Most importantly, nothing in Lahrmann directs one of skill in the art to binders having low levels of aromatic moieties. Even if the teachings of a

primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the *desirability* of such a modification. *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1398 (Fed Cir. 1989).

Indeed, Lahrmann teaches that the use of such thermally cured binders is optional only and is not necessary to the obtainment of desirable performance properties.

Thus, nothing in Lahrmann leads one of skill in the art to view thermally curable binders, and most importantly, thermally curable binders *having less than 5% aromaticity*, as a necessary component.

Thus, there is no suggestion in Lahrmann to do what Applicants' have done in regards to the selection of component (a2). Accordingly, Lahrmann cannot provide a prima facie case of obviousness with respect to the invention of independent claim 1.

Reconsideration and removal of the rejection is respectfully requested as to independent claim 1 and those dependent claims that incorporate the limitations of claim 1.

Respectfully Submitted,



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